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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,128	12/24/2003	John C. Reed	66821-0058	1734
41552	7590	01/08/2009	EXAMINER	
MCDERMOTT, WILL & EMERY			AUDET, MAURY A	
11682 EL CAMINO REAL				
SUITE 400			ART UNIT	PAPER NUMBER
SAN DIEGO, CA 92130-2047			1654	
			MAIL DATE	DELIVERY MODE
			01/08/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/748,128	REED ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MAURY AUDET	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 November 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 69,72-75 and 78-129 is/are pending in the application.  
 4a) Of the above claim(s) 83-87 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 69,72-75,78-82 and 88-129 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 2/26/07 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/19/08</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

Applicant's amendment and response are acknowledged.

### ***Election/Restrictions***

As stated previously, Applicant's amendment and response of 10/1/07 is acknowledged. New claims 87-129 are filed herein. Claims 83-87 remain withdrawn as to the non-elected method (appropriate claim identifier is required in response hereto as to claim 83). Claims 69, 72-75, 78-82, and 88-129 are examined on the merits as drawn to the elected TPI 927 compounds and complexes thereof (products). Due to the new grounds of rejection under 35 USC 103, the present action is sent being sent NON-FINAL.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The rejection of claims 69, 72-75, 78-82, and 88-129 under 35 U.S.C. 103(a) as being unpatentable over Nefzi et al. (*Tetrahedron Letters* (2000), 41(29), 5441-5446), is maintained for the reasons of record. Applicant's 2 arguments have been considered but are not found persuasive.

**As noted previously, Nefzi et al. is Applicant's own previous work.**

Applicant argues:

1. That the CAS compound stereochemistry is different from Applicant's own earlier work (Nefzi et al.)? And that the reference does not teach what CAS put into the system. The Examiner, although acknowledging Applicant's assertion, is unable to rectify that which CAS teaches to the public, at the time of Applicant's publication. Furthermore, even if this stereochemistry is not what the reference teaches, Applicant has indicated no plans or previous amendment to CAS to rectify this situation. Thus, the CAS reference stereochemistry teaching to the public, at the time of the Nefzi reference stands.

2. Applicant argues that Applicant's R3 does not teach a phenylpropyl moiety, as Applicant's earlier work (Nefzi et al.) does. Unless misread, it appears Applicant does have a phenylpropyl moiety option for R3, in Applicant's claim 69 at #17/31, as one of the options for R3.

The rejection is repeated below for continuity of record:

As discussed in the previous action, Nefzi et al. teach an efficient two-step synthesis of mono-, di-, and triureas from resin-bound amides, which bear very close (if not express)

limitations with the core structure options to that of elected TPI 927. See e.g. RN 295343-42-9 in the attached reference.

In the previous action, Applicant argues firstly, that Nefzi et al. does not teach the same stereochemistry as Applicant. This is not deemed persuasive, as neither does Applicant. Secondly, Applicant argues that Nefzi et al. does discloses a phenylpropyl substituent off the R3 position, as opposed e.g. other various close variants thereof, such as phenylethyl, as Applicant claims at R3 (differing only by a single C (carbon) extension)).

Based on a reanalysis of Nefzi et al., Applicant's own earlier work directed to the same products/intended use, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to create the TPI-927 compound with e.g. phenylethyl at position R3, or other well known/structurally related variants/anologs/homologs (namely as functional equivalents off the 3 R groups stemming from the required core structure) which Applicant was in possession of and processing greater than one year before the earliest effective filing date of the present application, absent evidence to the contrary that such minor substituent variations would not have led one of ordinary skill in the art to reasonably expect the same or closely similar results therefrom (e.g. in derepressing an inhibitor of IAP-inhibited caspase).

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAURY AUDET whose telephone number is (571)272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 1/2/09

/Cecilia Tsang/  
Supervisory Patent Examiner, Art Unit 1654